



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,198	01/06/2004	Matthew Banet	114079.121US2 (A-0002)	2631
23483	7590	01/10/2006	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP			ASTORINO, MICHAEL C	
60 STATE STREET			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	
			3736	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/752,198	Applicant(s) BANET ET AL.	
	Examiner Michael C. Astorino	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 1,6-11 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-5,12-27,31 and 32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 31-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 17, 2005.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: Claims 2-6 directed to login functionality;

Species 2: Claims 6-11 directed to alerts regarding vital sign data; and

Species 3: Claims 12-27 directed to transmitting and receiving an electronic file.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 28 and 29 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Eric Prah on January 6, 2006 a provisional election was made without traverse to prosecute the invention of I, claims 1-30, and species II claims 6-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-5, 12-27, and 31-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: element number 86 of figure 5, element number 162 of figure 6, and element number 208 of figure 8. Corrected

Art Unit: 3736

drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites, "the system of claim 1, wherein **the second interface** comprises a web page that displays an alert message associated with a patient." Claim 6 recites the limitation " **the second interface** " in line 1. There is insufficient antecedent basis for this limitation in the claim, since the applicant has not previously claimed a second interface. For the purposes of review the examiner will examine the claim as having only one interface since it is unclear what the second interface pertains to.

Claims 7-9 are rejected as being dependent on rejected claim 6.

Claim 10 states, “the system of claim 9, wherein the application software piece processes vital-sign data and data **associated** with a patient's age to generate the alert message.” Claim 11 states, “the system of claim 9, wherein the application software piece processes vital-sign data and data **associated** with a patient's gender to generate the alert message.” In both claim 10 and 11 it is unclear to the examiner what the association is between the age and gender respectively and the alert.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by Mault et al. US Patent Number 6,790,178.

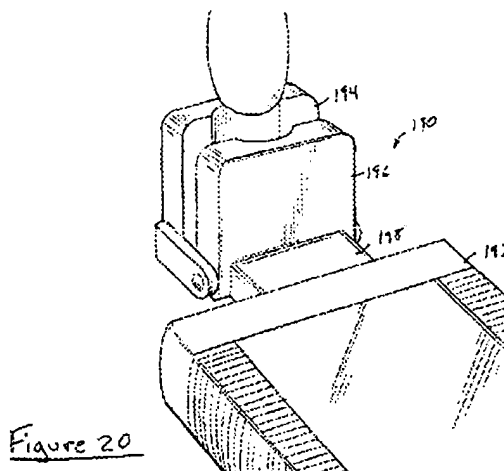
Art Unit: 3736

Claim 30. A system for monitoring a patient, comprising:

a vital-sign monitor integrated into a finger-worn unit comprising a sensor that measures data characterizing O.sub.2 saturation from the patient; (190, 194, and 196, see column 18, lines 60-67, and column 19 and lines 1-58)

a global positioning system for determining location-based data; (Column 12, lines 23-30) and

a processor, in wired or unwired electrical contact with the vital-sign monitor and the global positioning system, that receives and processes the O.sub.2 saturation and location-based data. (PDA 192, 198)



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3736

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phipps US Patent Number 6,579,231 B1 in view of Schulze et al. US Patent Number 6,443,890 B1.

In regards to claim 1, **Phipps teaches a system for monitoring a patient, comprising:**

- a vital-sign monitor comprising sensors (element number 16, column 3, lines 58-65) for measuring from the patient at least one of the following vital-sign data: O.sub.2 saturation, blood pressure, heart rate, electro-cardiogram, respiratory rate, temperature and blood glucose level;
- a global positioning system (GPS satellite 24 and GPS Receiver 60) for determining location-based data;
- a wireless transmitter (2-Way Interactive Paging Network 24, 28 and PCS of Analog 26, 30; see column 4, 1-67) configured to receive the vital-sign and location-based data and wirelessly transmit these data through a wireless network;
- a gateway software piece that receives and processes the vital-sign and location-based data from the wireless network; (CRS 18)
- a database software piece that communicates with the gateway software piece to receive the vital-sign and location-based data and stores them in a computer memory (20 database); and
- an user interface that displays the vital sign and location-based data (inherent via CRS and Call center that the data is displayed; see column 7, lines 13-32 and 46-55), but Phipps does not disclose Internet-based a user interface. However, Schulze et al. a reference in an analogous art discloses the use of a wireless network that has an Internet-based user interface to display data (element number 26). It would have been obvious to one of ordinary skill in the art at the

Art Unit: 3736

time the invention was made to substitute the user interface of Phipps in view of the Internet-based user interface of Schulze et al., since both use a PCS/Cellular type of communication protocol that stores data at a server and database, and Schulze et al. teaches the suggestion of monitoring an individual over the Internet as the network protocol after the wireless functionality is completed (column 1, lines 49-50).

Claim 6. The system of claim 1, wherein the second interface comprises a web page that displays an alert message associated with a patient. (Schulze et al. figure 1, medical provider using the Internet 26 to view data at the data archive 30).

Claim 7. The system of claim 6, further comprising an application software piece that processes vital-sign data to generate the alert message. (Column 7, lines 22-32)

Claim 8. The system of claim 7, wherein the application software piece comprises an algorithm that compares vital-sign data to a pre-determined level to generate the alert message. (Column 7, lines 22-32)

Claim 9. The system of claim 6, wherein the system further comprises an application software piece configured to process multiple vital-sign data to generate the alert message. (column 3, lines 58-65)

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phipps US Patent Number 6,579,231 B1 and Schulze et al. US Patent Number 6,443,890 B1 in further view of Surwit et al. US Patent Number 6,024,699.

Phipps and Schulze et al. teaches the use of alarm and keeping in memory the patient's name and patient data but does not disclose keeping in memory age or gender of the patient. However Surwit et al., a reference in an analogous art at the time of the invention discloses keeping age and gender in memory. (See Surwit. et al. figure 8.

Bilhome, Moe 25 yr. old Male, Type 1-5 yrs, Insulin-5yrs.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the patient information of Phipps and Schulze et al. in view of age and gender in the patient history of Surwit et al., since Surwit et al. implies doing recording the gender and age of a patient is common practice in the art.

Allowable Subject Matter

Claims 28-29 are allowed.

Conclusion

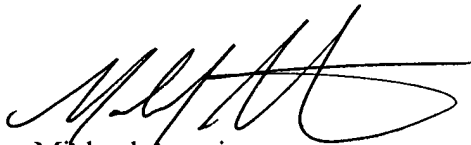
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael C Astorino** whose telephone number is **571-272-4723**.

The examiner can normally be reached on Monday-Friday, 8:30AM to 3:30PM.

Art Unit: 3736

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Michael Astorino', with a stylized, flowing script.

Michael Astorino
January 8, 2006